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10/765,519	01/27/2004	Peter C. Johnson II	200206870-1	1025

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EXAMINER	
FEARER, MARK D	

ART UNIT	PAPER NUMBER
2143	

NOTIFICATION DATE	DELIVERY MODE
09/23/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/765,519	JOHNSON ET AL.	
	Examiner	Art Unit	
	MARK D. FEARER	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-12,14-22 and 24-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 5-12, 14-22 and 24-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's Amendment filed 12 December 2007 is acknowledged.
2. Accordingly, the **Final rejection of 27 March 2007 is withdrawn**.
3. Claims 4, 13, 23 and 27 have been cancelled.
4. Claims 1-2, 5, 10, 18, 21 and 24 have been amended.
5. Claims 1-3, 5-12, 14-22 and 24-26 are pending in the present application.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 24 claims the non-statutory subject matter of a program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the

computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed programs are not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3, 5, 7-8, 10, 12 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yairi et al. (US 20040078424 A1).

Consider claims 1, 5 as applied to claim 1, and 10. Yairi et al. discloses a system and method, comprising: an HTTP gateway adapted to establish a communication link with an HTTP server; and an instant messaging communication subsystem adapted to enable communication between a plurality of instant messaging user interfaces coupled to the instant messaging communication subsystem; wherein, the HTTP gateway establishes a communication link with the instant messaging communication subsystem

and wherein the HTTP gateway is adapted to receive commands from the instant messaging user interfaces, convert the commands to HTTP requests, send the HTTP requests to the HTTP server, receive HTTP responses to the HTTP requests from the HTTP server, and send the HTTP responses to the instant messaging user interfaces via the instant messaging communication subsystem ((“Once an embedded IM client in a mobile terminal (e.g., mobile terminal/IM client 113) learns about a web service (e.g., web service 125), web service proxy module 103 facilitates communications between the embedded IM client 113 and the web service 125 based on the data obtained by web service broker 105. As indicated above, the web service 125 appears to the IM client 113 as a "virtual" IM user. Generally, the IM client 113 sends a message through the mobile IM server 111 to the web service proxy 103. The service controller 107 determines the service description used by the web service (e.g., by retrieving the web service's corresponding metadata from database 133), obtains any necessary parameters from the IM client 113, translates the information into a message format understandable by the web service 125, and forwards the message to the requested web service 125. Upon receiving the response from the web service 125, the web service proxy 103 translates the message into IM messages understandable by the IM client 113, and forwards the message to the requesting IM client 113. Note that the web service proxy provides the role of a stateless, data format translator between the IM and web services protocols. The service controller 107 contains the logic which drives the service invocation behavior of the gateway.”) paragraph 0033); wherein the HTTP gateway selects said instant messaging, communication subsystem from among a

plurality of instant messaging communication subsystems using a configuration file of the HTTP gateway stored on the system ((“Web service controller 107 in step 305 obtains the description metadata corresponding to the selected web service from web service database 133, and analyzes the metadata to determine parameters that web service proxy 103 needs to obtain from IM client 211 in step 307 prior to sending a message to the web service provider in step 309. The web service metadata may indicate that web service proxy 103 only needs to send a single message to a web service provider with a single input parameter, or may indicate that multiple messages and/or multiple input parameters are needed. In addition, in step 305 web service controller 107 determines whether a composite service was requested, or whether a composite service is available and can be offered to the user as a follow-up option. Composite services can be described using known protocols such as web services flow language (WSFL). WSFL is an XML language for describing web services compositions as part of a business process definition, as is known in the art.”) paragraph 0040).

Consider claims 3 as applied to claim 1, and claim 12 as applied to claim 10. Yairi et al. discloses a system and method comprising a back-end database connected to the HTTP server, wherein the HTTP server is adapted to query the back-end database in preparing the HTTP responses ((“Web service broker module 105 provides registration and discovery for web services accessed through IM/WS gateway 101, and stores in database 133 any data needed for the interaction between the end user and a requested web service. The stored data may include web service description metadata,

web service composition metadata, or web service workflow logic. The stored data may additionally include program control logic, payment information, or any other information about the web service or web service provider that may be presented to the user, e.g., during web service discovery or activation. This stored data may subsequently be referred to either collectively or specifically as web service metadata or simply as metadata.") paragraph 0027).

Consider claims 7 as applied to claim 1, and 15 as applied to claim 10. The system of claim 1, wherein the HTTP gateway polls the instant messaging communication subsystem for the commands from the instant messaging user interfaces (("A mobile terminal, comprising: a processor; an input device; a display screen; memory storing computer readable instructions that, when executed by the processor, perform a method for communicating with a plurality of web services, comprising (i) sending to an instant messaging web services gateway an instant messaging (IM) formatted request to communicate with a predetermined web service in the plurality of web services; (ii) receiving an IM-formatted query message from the gateway for each input required by the predetermined web service; (iii) generating an input value for each input required by the predetermined web service; (iv) sending an IM-formatted response message to the gateway for each determined input value; and (v) receiving an IM-formatted web service response from the gateway based on each of the sent input values.") Claim 24).

Consider claim 8 as applied to claim 1 and 16 as applied to claim 10. Yairi et al discloses a system and method wherein conversion of commands from instant messaging user interfaces into the HTTP requests comprises creation of form variables by the HTTP gateway based on the commands (("According to a first aspect of the invention, a gateway data processing device acts as an intermediary between IM users and web services. The gateway communicates with an instant messaging (IM) server via a first network interface, and communicates with a plurality of web service providers through a second network interface. The gateway stores a database of information on the available web services, such as communication details, required inputs, expected outputs, and the like. The gateway also includes a proxy module that translates messages between formats understandable by IM users and each web service. When the proxy receives from an IM user an IM-formatted request for a web service, the proxy retrieves information from the database corresponding to the requested web service, and generates one or more web service-formatted request(s) corresponding to the requested web service using the retrieved information. Upon creation of the web service formatted message, the proxy sends the web service-formatted request(s) to a specific web services provider that provides the requested web service. One or more web service response(s) is received by the proxy, reformatted for the IM system, and delivered to the IM server destined to the originating mobile IM user.") paragraph 0010).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2, 6, 9, 11, 14, 17-22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yairi et al. (US 20040078424 A1) in view of Kay et al. (US 7146404 B2).

Consider claim 2 as applied to claim 1 and 11 as applied to claim 10. Yairi et al. discloses a system and method comprising: an HTTP gateway adapted to establish a communication link with an HTTP server; and an instant messaging communication subsystem adapted to enable communication between a plurality of instant messaging user interfaces coupled to the instant messaging communication subsystem; wherein, the HTTP gateway establishes a communication link with the instant messaging communication subsystem and wherein the HTTP gateway is adapted to receive commands from the instant messaging user interfaces, convert the commands to HTTP requests, send the HTTP requests to the HTTP server, receive HTTP responses to the HTTP requests from the HTTP server, and send the HTTP responses to the instant messaging user interfaces via the instant messaging communication subsystem. However, Yairi et al. fails to disclose a system and method comprising at least one instant messaging bot, wherein the HTTP gateway is coupled to the instant messaging communication subsystem via the at least one instant messaging bot and the instant messaging bot receives the commands from the instant messaging user interfaces and sends HTTP responses to the user interfaces via the instant messaging communication subsystem. Kay et al. discloses a method for performing authenticated access to a service on behalf of a user comprising at least one instant messaging bot, wherein the HTTP gateway is coupled to the instant messaging communication subsystem via the at least one instant messaging bot and the instant messaging bot receives the commands from the instant messaging user interfaces and sends HTTP responses to the user

interfaces via the instant messaging communication subsystem ((“To gain access to the sibling services, the interactive agent servers must be granted a trust relationship with the sibling services. Hence, the provider of the IM and sibling services grant access to the sibling services databases without requiring a password. In doing so, the service provider is trusting the interactive agent to properly handle the access privileges. Such a trust relationship is possible because of the very nature of instant messaging. For a user to send a message from a given screen name, they must be pre-authenticated by the instant messaging service. That service authentication mechanism is the same mechanism (and the same screen name and password) that is used by the sibling services. Therefore, the fact that a message is received from the screen name proves in itself that the user has access to the data in question. In accordance with the preferred embodiment, once the trust relationship is established, the interactive agent would have access to user information stored in the sibling services. The interactive agent can then manipulate the data stored in sibling services on behalf of the user, since the data belongs to that user. In certain embodiments, Personal Bots are used to store all of the user's personal data in the interactive agent user profile. In accordance with the present embodiment, it is possible to increase the synergy of the personal bot with the method of the invention, if the interactive agent granting access to the user's personal data was previously stored in the sibling services. In this case, the user would then have an integrated calendar, for example, that is manipulateable either through the previously extant web interface, as well as through the personal bot, by issuing statements such as

"I'm having lunch with Bob Smith on Tuesday."") column 16 lines 44-67 and column 17 lines 1-8).

Yairi et al. discloses a prior art web services via instant messaging comprising: an HTTP gateway adapted to establish a communication link with an HTTP server; and an instant messaging communication subsystem adapted to enable communication between a plurality of instant messaging user interfaces coupled to the instant messaging communication subsystem; wherein, the HTTP gateway establishes a communication link with the instant messaging communication subsystem and wherein the HTTP gateway is adapted to receive commands from the instant messaging user interfaces, convert the commands to HTTP requests, send the HTTP requests to the HTTP server, receive HTTP responses to the HTTP requests from the HTTP server, and send the HTTP responses to the instant messaging user interfaces via the instant messaging communication subsystem upon which the claimed invention can be seen as an improvement.

Kay et al. teaches a prior art comparable method for performing authenticated access to a service on behalf of a user comprising at least one instant messaging bot, wherein the HTTP gateway is coupled to the instant messaging communication subsystem via the at least one instant messaging bot and the instant messaging bot receives the commands from the instant messaging user interfaces and sends HTTP responses to the user interfaces via the instant messaging communication subsystem.

Thus, the manner of enhancing a particular device (method for performing authenticated access to a service on behalf of a user comprising at least one instant

messaging bot, wherein the HTTP gateway is coupled to the instant messaging communication subsystem via the at least one instant messaging bot and the instant messaging bot receives the commands from the instant messaging user interfaces and sends HTTP responses to the user interfaces via the instant messaging communication subsystem) was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in Kay et al. Accordingly, one of ordinary skill in the art would have been capable of applying this known improvement technique in the same manner to the prior art web services via instant messaging comprising: an HTTP gateway adapted to establish a communication link with an HTTP server; and an instant messaging communication subsystem adapted to enable communication between a plurality of instant messaging user interfaces coupled to the instant messaging communication subsystem; wherein, the HTTP gateway establishes a communication link with the instant messaging communication subsystem and wherein the HTTP gateway is adapted to receive commands from the instant messaging user interfaces, convert the commands to HTTP requests, send the HTTP requests to the HTTP server, receive HTTP responses to the HTTP requests from the HTTP server, and send the HTTP responses to the instant messaging user interfaces via the instant messaging communication subsystem of Yairi et al. and the results would have been predictable to one of ordinary skill in the art, namely, one skilled in the art would have readily recognized a system and method of application hosting.

Consider claims 6 as applied to claim 1, 14 as applied to claim 10, and 20 as applied to claim 18. Yairi et al., as modified by Kay et al., discloses a system and method wherein the HTTP gateway is adapted to map the HTTP requests to specific paths on the HTTP server (Yairi et al., paragraph 0007 and Kay et al., column 8 lines 14-48).

Consider claim 9 as applied to claim 1, and 17 as applied to claim 10. Yairi et al., as modified by Kay et al., discloses a system and method wherein transmitting the HTTP responses to the instant messaging user interfaces comprises extracting text portions of the HTTP responses and communicating the text portions to the instant messaging user interfaces (Kay et al., column 9 lines 47-67 and column 10 lines 1-16).

Consider claim 18. Yairi et al., as modified by Kay et al., discloses a system comprising: means for establishing a communication link between an HTTP gateway and an HTTP server; means for transmitting commands from a plurality of instant messaging user interfaces coupled to an instant messaging communication subsystem to the HTTP gateway via at least one instant messaging bot; means for converting the commands to HTTP requests (Yairi et al., paragraph 0010); means for transmitting the HTTP requests to the HTTP server (Kay et al., column 4 lines 1-28); means for generating HTTP responses to the HTTP requests; and means for transmitting the HTTP responses via the at least one instant messaging bot to the instant messaging user interfaces (Kay et al., column16 lines 44-67 and column 17 lines 1-8) wherein the

HTTP selects said instant messaging communication subsystem from among a plurality of instant messaging communication subsystems using a configuration file of the HTTP gateway stored on the system (Yairi et al., paragraph 0040).

Consider claim 19, as applied to claim 18. Yairi et al., as modified by Kay et al., discloses a system wherein generating HTTP responses to the HTTP requests comprises a means for querying a back-end database (Yairi et al., paragraph 0027).

Consider claim 21. Yairi et al., as modified by Kay et al., discloses a gateway comprising: a CPU; a storage device coupled to the CPU and containing executable code; wherein, upon executing the code, the processor receives commands from instant messaging user interfaces, converts the commands to HTTP requests (Kay et al., column16 lines 44-67 and column 17 lines 1-8), sends the HTTP requests to an HTTP server, receives HTTP responses from the HTTP server, and sends the HTTP responses to the instant messaging user interfaces via an instant messaging communication subsystem (Kay et al., column 4 lines 1-28); a configuration file, wherein the CPU accesses data in the configuration file to determine with which of a plurality of instant messaging subsystems the gateway establishes a communication link; wherein the configuration file is usable to determine to which of a plurality of HTTP servers the gateway sends said HTTP requests (Yairi et al., paragraph 0040).

Consider claim 22, as applied to claim 21. Yairi et al., as modified by Kay et al., discloses a gateway wherein the CPU further comprises executable code for an instant messaging bot, wherein the instant messaging bot receives commands from the instant messaging user interfaces and sends HTTP responses to the users interfaces via the instant messaging communication subsystem (Kay et al., column16 lines 44-67 and column 17 lines 1-8).

Consider claim 24. Yairi et al., as modified by Kay et al., discloses a storage device containing software that, when executed by a processor, causes the processor to: receive commands from a plurality of instant messaging user interfaces; convert the commands to HTTP requests (Yairi et al., paragraph 0010); transmit the HTTP requests to an HTTP server; receive HTTP responses from the HTTP server; and transmit the HTTP responses to the instant messaging user interfaces via an instant messaging communication subsystem (Kay et al., column 4 lines 1-28): wherein receiving commands from or transmitting HTTP responses to the of instant messaging user interfaces comprises accessing a configuration file to determine with which of a plurality of instant messaging communication subsystems to establish a communication link (Yairi et al., paragraph 0040).

Consider claim 25, as applied to claim 24. Yairi et al., as modified by Kay et al., discloses a storage device wherein receiving commands from a plurality of instant

messaging user interfaces comprises receiving the commands via an instant messaging bot (Kay et al., column16 lines 44-67 and column 17 lines 1-8).

Consider claim 26, as applied to claim 24. Yairi et al., as modified by Kay et al., discloses a storage device wherein receiving HTTP responses from the HTTP server comprises querying a back-end database (Yairi et al., paragraph 0027).

Response to Arguments

12. Applicant's arguments filed with respect to claims 1-3, 5-12, 14-22 and 24-26 have been considered but are moot in view of the new ground(s) of rejection.

The examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider each of the cited references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage disclosed by the examiner.

Conclusion

13. Any response to this Office Action should be faxed to (571) 273-8300 or mailed to:

Commissioner for Patents

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Hand-delivered responses should be brought to

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Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark Fearer whose telephone number is (571) 270-1770. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Mark Fearer
/M.D.F./
September 12, 2008

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2143